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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,052	06/20/2003	Aaron Kelly	31132.129	6026

46333 7590 01/09/2007

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EXAMINER	
PHILOGENE, PEDRO	
ART UNIT	**PAPER NUMBER**
3733	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/600,052	KELLY ET AL.	
	Examiner	Art Unit	
	Pedro Philogene	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 October 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) _____ is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19 and 26-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/19/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/19/06 has been entered.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 101-103,106-110,112-113 of copending Application No. 09/924,298. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference

between claims 1-19 of the application and claims 101-103,106-110,112-113 of the copending application lies in the fact that the copending application claims include many more elements and are thus more specific. Thus, the invention of claims 101-103,106-110,112-113 of the copending application is in effect a "species" of the "generic" invention of claims 1-19. It has been held that the generic invention is "anticipated" by the "species" See in re Goodman, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims 1-19 of the application are anticipated by claims 101-103,106-110,112-113 of the copending application, they are not patentably distinct from claims 101-103,106-110,112-113.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2, 17, 18,19,26-29,32,33 are rejected under 35 U.S.C. 102(e) as being anticipated by Baumgartner (5,370,697).

With respect to claims 1, 2, 26, 34, Baumgartner discloses a body member (23,25,26)) for use with a shell (14,15) to form an implantable endoprosthesis, the body member comprising a first component (255) formed from a wear resistant first material, and a second component (23) formed from a resilient second material, wherein the body member is adapted to articulate with the shell (14,15) such that one or more

surface of the shell come into contact with the first component (25), as best seen in FIGS.1-3, a third portion (26) positioned at least partially between the first and second portions, the third portion formed from a resilient material; as best seen in FIG.2. the first component and the second component are both made from resilient material; as set forth in column 3, lines 53-55.

With respect to claims 17-19, 27-29,32,33, Baumgartner discloses all the limitations, as set forth in column 2, lines 50-68, column 3, lines 1-64.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3-7,10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumgartner (5,370,697).

With respect to claims 3-16, it is noted that Baumgartner teaches all the limitations except for the material being one or more metal and the metal is an alloy and the alloy is cobalt-chrome alloy, and the material is ceramic herein the ceramic is alumina or zirconia and a molecular weight ranging from about 5.0 x 10E5 grams/mol to about 6.0 x 10E6 grams/mol; polyethylene having modulus of elasticity ranging from about 0.7 to about 3.0 Gpa; A polyethylene cross-linked to an extent ranging between about 0 to about 50% as measure by a swell ratio; polymer comprising (PEEK) and the

second material comprises polymer having durometer ranging from about 75A to about 65D; as claimed by applicant. However, it would have been obvious to one having ordinary skill in the art to use any known or preferred material; since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. As to the ranges and percentages as claimed by applicant. It would have been obvious to one having ordinary skill in the art to reach an optimum range, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claims 30, 31, 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumgartner (5,370,697) in view of Buttner-Janz et al. (5,401,269).

With respect to claims 30,31,34, it is noted that Baumgartner discloses all the limitations, except for an opening adapted to receive a first projection and second projection of the shell; as claimed by applicant. However, in a similar art, Buttner-Janz et al evidence the use of a core having an opening adapted to receive a projection of the shell to limit the rotational movement and the bending movement of the prosthesis.

Therefore, given the teaching of Buttner-Janz et al, it would have been obvious to one having ordinary skill in the art, at the time the invention was made to modify the device of Baumgatner, as taught by Butter-Janz et al to limit the rotational movement and the bending movement of the prosthesis.

Response to Amendment

Applicant's arguments filed 10/30/06 have been fully considered but they are not persuasive. Applicant's argument about the restriction and double patenting rejection is not persuasive. The restriction is proper for the simple reason that he double patenting rejection is proper. For the double patenting rejection the applicant's attention is directed towards the claims in the 09/924,298 application. In those claims applicant only claiming the body member. Although the shell structure is in the claims, it is not being positively claimed. Therefore, the restriction and the double patenting are proper.

Applicant's arguments, see Remarks, filed 10/19/06, with respect to the rejection(s) of claim(s) 1-19, 26-34 under 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Baumgartner (5,370,697).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6,419,706 Graf 7-2002

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pedro Philogene
January 02, 2007

PEDRO PHILOGENE
PRIMARY EXAMINER